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EXAMINER

LAUFER, P

ART UNIT

PAPER NUMBER

2766

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/841,950

Applicant(s)

Mark D. Riggins

Examiner 7033064160

Pinchus M. Laufer

Group Art Unit

2766



☒ Responsive to communication(s) filed on 22 Feb 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Substitute ~~Notice of Draftsperson's Patent Drawing Review~~, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 6, 7, 8

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 (Substitute)

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Claim Rejections - 35 U.S.C. § 101

1. 35 U.S.C. § 101 reads as follows:
"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
2. Claims 1-29 are rejected under 35 U.S.C. § 101 because they are non-statutory. Claims 1-29 are directed to Functional Descriptive Material, i.e., computer program *per se*. See *Examination Guidelines for Computer Related Inventions* 1184 OG 87, 89 (3/26/1996) III.B.1.(a) which states:
Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are neither physical "things" nor statutory processes.
Note that based on the disclosure, where "engine" and "keysafe" are described as software or files, the claims are directed to a collection of software routines.

Observation with Respect to Claim Language

3. The system claims contain "intended use" language. For example, claim 1: "a keysafe *for* ...".
4. The terms "applet" and "servlet" were understood to mean programs executable on the client and server respectively.

Claim Rejections - 35 U.S.C. § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-14, 16, 18, 21, 22, and 25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In general: Method steps or system elements should not be couched in "wherein" clauses. A positive recitation is needed. If a structural element or method step is presented in a wherein clause, it is unclear whether this feature is meant to be claimed since the presumption is that language included in a claim is intended to be considered. (Phrases like "wherein said method further includes the steps of ..." do not suffer from this ambiguity. This construction makes it clear that the method includes the recited steps.)

Claim 1: "engine" is not defined. Although the specification does mention the word "engine" it does not teach details of the engine and how it differs from other programs or processes which

provide processing power or an execution means for the instructions. Thus one of ordinary skill in the art is not apprised of the subject matter applicant claims with adequate specificity.

Claims 2, 8, 16, and 22: The phrases "SSL technology" and "digital signature technology" are not clear. What scope does "technology" encompass? A possible correction would be to delete "technology".

Claims 7 and 21: The phrase "global certificate" is not defined.

Claim 10: The phrase "corporate firewall" is not defined.

Claim 11 and 25: The phrase "global firewall" is not defined.

Claims 2-10 and 13: Applicant's inclusion of item of process steps into systems claim 1 by dependency creates improper hybrid claim and hence this combination of claimed subject matter is confusing. This confusion occurs, since it can not be determined if the combined claim is to be classified as only one of the statutory classes of invention, that is:

- A) a process, or
- B) a machine, or
- C) a manufacture, or
- D) a composition of matter.

Note ex parte Lyell, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) and MPEP § 2173.05(p).

Furthermore it is unclear, whether the claims mean to include all the limitations of claims 2-10, and 13.

For at least the aforementioned reasons the claims are rendered indefinite as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant did not teach the details of the communication and servlet host engines as claimed in claim 1, the means for providing the applets of claims 29 and 30 and the method of providing the applet of

claim 15. It would require undue experimentation for one of ordinary skill in the data processing art to determine the details of these above said engines and means. Although the specification does mention the word "engine" it does not teach details of the engine and how it differs from other programs or processes which provides processing power or an execution means for the instructions. It would take undue experimentation for one of ordinary skill in the data processing art to determine details of how the engine differs from other well known processes or programs or execution means and what the engine is made of. Moreover, teachings regarding the applets, servlets, the details of the key management, the implementation of the three modes of service establishment in the specification lack the specificity required to meet 112 first paragraph requirements, e.g., details of how the servlets and proxy and service are integrated with each other and with the applet to communicate with the server to process request directed to them. The present application does not disclose such details in depth to make and use the invention without undue experimentation

The examiner contends that it would require undue experimentations for one of ordinary skill in the Internet communication art to make and use the claimed invention for the reasons set forth hereinabove. Applicant is reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

Claim Rejections - 35 U.S.C. § 103

9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. Claims 1-30 are rejected under 35 U.S.C. § 103 as being unpatentable over Vogler ('683) in view of Netscape version 2. Vogler teaches a system which controls access to a service through downloading of an access connect applet to a prospective client after authentication. Vogler does not teach the use of a key safe that stores a key which enables access to the service. However, Vogler [3:33-36] teaches that the access connect applet may gather authentication information, where the "type and extent of client information collected are application dependent". In light of this teaching it would have been obvious to employ Vogler's access facilitator with home banking systems, Internet

shopping, and the like employing a standard browser such as Netscape on the client side. Such an implementation would include a piece of secret information to control access (i.e., a key) and could entail any or all the standard security techniques used in on-line commerce. Note that Netscape supports SSL and public key certificates. (ElGamal ('390) is supplied as a reference to SSL.) With respect to negotiating a protocol (claims 3 and 17), SSL negotiates which algorithm to use for the session encryption. With respect to claims 10-11 and 24-25, the term "firewall" is broadly used to describe any internetwork security scheme, therefore both the secured service, and the global server (identified with the access facilitator) have firewalls. With respect to claims 7 and 21, the certificate provided by the client which is signed by a trusted authority is understood as a "global" certificate since it is available to all by virtue of the trusted authority public key.

11. Claims 1-30 are rejected under 35 U.S.C. § 103 as being unpatentable over Weber ('668). Weber teaches providing banking and home shopping with transaction payment over the Internet through a virtual point of sale interface. The global server is identified with the merchant, and the downloadable applet for updating the vPOS is found at column 61 lines 59-63. See columns 6 lines 22 -column 17 line 17, Figures 4-5; Column 18 line 5 - column 19 line 25, Figures 6-7; Column 61, lines 59-63. Although the description focuses on secure HTTP reference is made to Java Applets (figs 31 and 32). Therefore, it would have been obvious to one of ordinary skill in the art to employ servlets and applets motivated by the platform independence of Java objects which obviates the need for platform customization. Firewall is interpreted broadly as noted in the previous paragraph.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Information Regarding Communication with the PTO

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 7:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

April 16, 1999

Pinchus M. Laufer
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Art Unit 2766